

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte CLYDE H. SHEPPARD and HYMAN R. LUBOWITZ

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Appeal No. 1999-0207  
Application No. 08/477,560

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ON BRIEF

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Before KIMLIN, GARRIS, and WALTZ, Administrative Patent Judges.  
WALTZ, Administrative Patent Judge.

**DECISION ON APPEAL**

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 14 through 16.<sup>1</sup> Claims 1-5, 8-16, 19-33 and 35 are pending in this application. The final rejection of claims 1-5, 8-16, 19-33 and 35 under the judicially created doctrine of obviousness-type double patenting over claims 1-11, 14-19, 22-28, 30-34 and 36-45 of appellants' U.S. Patent No. 5,645,925 is not appealed (Brief, page 1; Answer, page 3).

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<sup>1</sup> Appellants' amendment, subsequent to the final rejection, dated Feb. 2, 1998, Paper No. 17, cancelling claims 6, 7 and 34, has been entered. See the Advisory Action dated Apr. 3, 1998, Paper No. 18.

According to appellants, the invention is directed to polymeric blends comprising a mixture of at least one crosslinkable oligomer and at least one compatible, noncrosslinking polymer from a different chemical family (Brief, page 2). A copy of illustrative claim 14 is reproduced below:

14. An advanced composite blend comprising a mixture of at least one crosslinkable oligomer and at least one compatible, noncrosslinking polymer from a different chemical family, wherein the oligomer comprises two ends, each of which comprises two unsaturated, crosslinkable end-cap moieties and wherein, prior to curing, the oligomer has an average formula weight less than that of the polymer.

Claims 14 through 16 stand rejected under 35 U.S.C. § 112, first paragraph, "because the specification, while being enabling for those cross-linking oligomers disclosed in the specification page 6, line 12-page 8, line 5, does not reasonably provide enablement for tetrakis isocyanates end caps as to the oligomer." Answer, page 3. We reverse the examiner's rejection essentially for the reasons set forth in the Brief, Reply Brief, and the reasons below.

#### **OPINION**

Claims 14 through 16 stand rejected by the examiner for failure to fulfill the enablement requirement of 35 U.S.C. § 112, namely because the specification does not enable any person skilled in the art to make and use the invention "commensurate in scope

with these claims." Answer, page 3. The examiner finds that "[t]etrakis isocyanate cross-linking caps would yield polymers different from those disclosed and intended by applicants." *Id.* The examiner further submits that undue experimentation would be required to produce multidimensional polyurethanes from tetrakis isocyanates end-capped oligomers (Answer, page 4). The examiner finds that the area of technology is "complex and unpredictable" and this alone is enough to create reasonable doubt as to the accuracy of broad statements put forth as enabling support (*id.*).

It is well settled that the examiner bears the initial burden of setting forth a reasonable explanation as to why it is believed that the scope of protection provided by the claims is not adequately enabled by the description of the invention provided in the specification, including the provision of sufficient reasons for doubting any assertions in the specification as to the scope of enablement. See *In re Wright*, 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993). Nothing more than objective enablement is required, and therefore it is irrelevant whether this teaching of enablement is provided through broad terminology or illustrative examples. See *In re Marzocchi*, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971).

Appeal No. 1999-0207  
Application No. 08/477,560

The examiner has failed to provide sufficient and convincing reasoning or evidence to meet the initial burden of establishing non-enablement. The examiner does not provide any support for his conclusion that tetrakis isocyanate cross-linking caps would yield polymers different from those disclosed and intended by appellants (Answer, page 3). Even assuming *arguendo* that the examiner had credible reasoning or evidence to support this conclusion, the inclusion of one species within the generic scope of claim 14 that would not produce the desired polymer composite blend does not render the claim unpatentable for lack of enabling disclosure. One of ordinary skill in the art would have recognized if this species of end cap oligomers yielded products outside the scope of the claims and accordingly the claims would not include this species. See *In re Angstadt*, 537 F.2d 498, 502, 190 USPQ 214, 218 (CCPA 1976). Furthermore, merely because the art is "complex and unpredictable" is not alone sufficient for non-enablement of broad statements in the specification, but is only one factor to be considered. See *In re Wands*, 858 F.2d 731, 735-737, 8 USPQ2d 1400, 1402-1404 (Fed. Cir. 1988).

For the foregoing reasons and those set forth in the Brief and Reply Brief, we determine that the examiner has not met the initial burden of establishing that appellants have failed to fulfill the

Appeal No. 1999-0207  
Application No. 08/477,560

enablement requirement of the first paragraph of 35 U.S.C. § 112.  
Accordingly, the examiner's rejection of claims 14 through 16 under  
35 U.S.C. § 112, ¶1, is reversed.

The decision of the examiner is reversed.

**REVERSED**

EDWARD C. KIMLIN	)	
Administrative Patent Judge	)	
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	)	
	)	
	)	BOARD OF PATENT
BRADLEY R. GARRIS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
THOMAS A. WALTZ	)	
Administrative Patent Judge	)	

TAW/jrg

Appeal No. 1999-0207  
Application No. 08/477,560

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